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EXAMINER

BOVEJA, NAMRATA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/669,791	Applicant(s) WILSON, JOSEPH G.	
	Examiner PINKY BOVEJA	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 12 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 8-11, 13-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 and 12 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 02/19/2008.
2. Claims 1-7, 12, and 24, have been cancelled, and claims 8-11, 13-23, and 25 are presented for examination.
3. Amendments to the claims 8-11, 19, and 25, have been entered and considered.

Claim Rejections - 35 USC § 112

4. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the claim introduces the limitation "receiving a second request," and this constitutes new matter, as this claim limitation is not supported by the specification. Applicant has also failed to identify any support for this limitation in the submitted amendment. In fact, paragraph 9 of the Applicant's specification states the following verbatim:

"Applicant has further developed an innovative method of delivering content to an audience member based on an audience member comprising the steps of: receiving a request for a first website page from the audience member; storing a cookie associated with the first website page in a computer associated with the audience member; identifying a unique identifier for the audience member in the cookie; associating the audience member with profile data based on the unique identifier; associating the audience member with a segment of audience

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members based on the profile data; and delivering content to the audience member based on the association of the audience member with the segment of audience members.”

So, per Applicant's own specification, there is only one request made, and in response to this first request, content is delivered, and this is how the claim is interpreted. Also, the claim recites receiving a first request from a computer in response to transmission of a webpage page to the computer, and this constitutes new matter, because this limitation is not supported by the specification. Per paragraph 9 of the specification as quoted above, a request for a webpage is received not a first request is received in response to transmission of a website page to the computer. The claim is interpreted in light of the specification to mean that a request for a webpage is received. Appropriate correction is required.

5. *Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the claim introduces the limitation “in response to transmission of a second website page,” and this constitutes new matter, as this claim limitation is not supported by the specification. Applicant has also failed to identify any support for this limitation in the submitted amendment. It is interpreted to mean that in response to a request for a website page. Appropriate correction is required.*

6. *Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply*

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with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the claim introduces the limitation "modifying the cookie transmitted to the computer," and this constitutes new matter, as this claim limitation is not supported by the specification. The specification discloses in paragraphs 24 and 27 that the cookies can be used to modify the profile data, but the Examiner is unable to find support for modifying the cookie itself. It is interpreted that cookie itself is being modified. Appropriate correction is required.

7. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, since *it is unclear what the Applicant is trying to claim here. For example, the claim recites receiving a first request, transmitting a cookie, transmitting a segment-targeting cookie, receiving a second request, and delivering content based on the second request, and it is unclear if the first cookie is different from the segment-targeting cookie, and even if they are different, what information is stored in the first cookie has not been disclosed. Furthermore, from the claim, it appears that no content is delivered based on the first request, and not until the user makes another second request is information ever*

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delivered to the user, however per the specification in paragraph 9, content is delivered based on a request and not a second request, so the claim is interpreted in light of the specification to mean that content is delivered based on a request.

Additionally, the claim recites receiving a first request from a computer associated with the audience member in response to transmission of a website page to the computer, and this is indefinite, because it is unclear what the Applicant means by this limitation. It is interpreted to mean that a request to transmit a website it received. Appropriate correction is required.

8. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, since it is unclear if the content that is delivered in claim 25, which depends on claim 8, is the same content that was delivered in claim 8. Furthermore, it is unclear if the content that is delivered in claim 25 to two different digital mediums is the same or different. It is interpreted to mean that identical content or supplemental content can be delivered to the same users via two different mediums. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8-10 and 13-23, are rejected under 102(b) as being anticipated by the Merriman et al. (Patent Number 5,948,061 hereinafter Merriman).

Disclaimer: Claim 8 was found to be deficient under U.S.C. 112 *first and*

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second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 8, Merriman teaches a method of delivering content to an audience member based on an audience member profile, comprising the steps of: receiving a *first* request from *a computer associated with* the audience member (col. 3 lines 24-28); *transmitting* a cookie *to the* computer associated with the audience member *in response to receiving the first request* (col. 3 lines 44-52 and col. 5 lines 10-49); identifying a unique identifier for the audience member in the cookie (col. 3 lines 44-52 and 64 to col. 4 lines 11 and col. 5 lines 11-21); *accessing* profile data *for the audience member in response to identification of the unique identifier for the audience member* (col. 5 lines 11-21 and 50-63); associating the audience member with a segment of audience members based on the profile data (col. 5 lines 50-63 and col. 6 lines 6-11); *transmitting a segment-targeting cookie, which includes a segment identifier for the segment of audience members, to the computer associated with the audience member* col. 5 lines 10-49); and delivering content to the audience member based on the *segment identifier* (col. 6 lines 6-11 and 27-59).

10. **Disclaimer:** Claim 9 was found to be deficient under U.S.C. 112 first paragraph.

To the extent the claimed invention was understood, the following art was applied.

In reference to claim 9, Merriman teaches the method *further comprising* the steps of: determining the absence of a *cookie with a* unique identifier for the audience member (col. 5 lines 10-49); setting a unique identifier for the audience member in a second cookie, and *transmitting* the second cookie *to the* computer associated with *the*

audience member (i.e. it is inherent the second cookie is *transmitted and* stored just like the first one, so that it can also be accessed in the database) (see at least col. 5 lines 10-49).

11. In reference to claim 10, Merriman teaches the method wherein the audience member is associated with a default segment of audience members as a result of *transmitting* the second cookie *to the computer associated with the audience member* (i.e. audience member is shown a generic ad *if the member is new and a targeted ad if there is a profile for the member*) (col. 5 lines 10-49).

12. In reference to claim 13, Merriman teaches the method further comprising the steps of: collecting profile data relating to the audience member (col. 5 lines 47-49); and storing the profile data for the audience member in a database (col. 5 lines 50-63 and 63-65 and col. 7 lines 45 to col. 8 lines 30).

13. In reference to claim 15, Merriman teaches the method wherein the segment of audience members may be defined by rules that recognize any common affinity between two or more audience members (i.e. users who like computers) (col. 6 lines 3-11).

14. In reference to claim 19, Merriman teaches a method of delivering content to an audience member based on profile data, comprising the steps of: storing audience member profile data in a database (col. 5 lines 50-63 and 63-65 and col. 7 lines 45 to col. 8 lines 30); associating the audience member with a segment of audience members based on the profile data (col. 5 lines 50-63 and col. 6 lines 6-11); identifying the segment of audience members with a segment identifier included in a segment-

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targeting cookie (col. 5 lines 50-63); *transmitting* the segment-targeting cookie to a computer associated with the audience member (col. 3 lines 45-47 and col. 5 lines 10-29); and delivering content to the audience member based on the segment identifier (col. 5 lines 43-47 and col. 6 lines 6-11 and 54-59).

15. In reference to claims 14 and 20, Merriman teaches the method wherein the step of collecting profile data includes collecting data from one or more sources selected from the group consisting of: a database, website page requests, advertisement requests (col. 6 lines 63 to col. 7 lines 12), user survey data (col. 5 lines 46-49), direct response data, and website search requests.

16. In reference to claims 16 and 23, Merriman teaches the method wherein the content is delivered to the audience member by a server selected from the group consisting of: an advertisement server (col. 5 lines 10 to col. 7 lines 44 and Figures 1 and 2), an email server, a streaming media server, and a website server.

17. In reference to claims 17 and 21, Merriman teaches the method wherein the step of associating the audience member with a segment of audience members further comprises the steps of: comparing the profile data of a plurality of audience members, and forming a segment of audience members based on the comparison of audience member profile data (i.e. if a user is one who like computers, sending him ads targeted to that segment) (col. 6 lines 3-11).

18. In reference to claims 18 and 22, Merriman teaches the method further comprising the steps of: periodically collecting additional profile data for the audience member (i.e. data regarding which ads the user has clicked on is obtained and surveys

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are also administered to the users) (col. 5 lines 50 to col. 6 lines 26, col. 6 lines 60-67, and col. 9 lines 39-46); and periodically determining which audience member segments the audience member is associated with, based on the profile data (col. 5 lines 50 to col. 6 lines 26, col. 6 lines 60-67, and col. 9 lines 39-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 11 is rejected under U.S.C. 103(a) as being unpatentable over Merriman in view of do Rosario Botelho et al. (Publication Number US 2002/0069105 hereinafter Rosario).

Disclaimer: Claim 11 was found to be deficient under U.S.C. 112 *first* paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 11, Merriman does not teach the method wherein when a user requests a website *domain*, the user is redirected to a redirect page as provided by the advertiser, and the *primary website* cookie associated with the user is updated based on the advertisement that is displayed to the user.

Rosario teaches the method wherein when a user requests a website *domain*, the user is redirected to a redirect page as provided by the advertiser, and the *primary*

website cookie associated with the user is updated based on the advertisement that is displayed to the user (page 3 paragraph 41 to page 4 paragraph 41, page 4 paragraph 48, page 5 paragraph 54, and Figure 6). It would have been obvious for Merriman to redirect users to a redirect page provided by the advertiser and to update the *primary website* cookie associated with the user based on the advertisement that is displayed to allow advertisers to track which user clicked on their advertisements and to prevent showing the users the same advertisements they had already seen.

20. Claim 25 is rejected under U.S.C. 103(a) as being unpatentable over Merriman in view of Official Notice.

Disclaimer: Claim 25 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 25, Merriman teaches the method wherein the first website page is delivered over a first digital medium, where the audience member is associated with an audience member profile data, and associating the audience member with a segment of audience members (col. 3 lines 24-63 and col. 5 lines 9 to col. 6 lines 59). Merriman does not teach providing the audience member with access to a second digital medium, sharing profile data in common between the two mediums, associating the audience member with a segment of audience members based on the common profile data, and delivering the content over the second digital medium. Official Notice is taken that is old and well known to provide the audience member with access to a second digital medium, share profile data in common between the two mediums,

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associate the audience member with a segment of audience members based on the common profile data, and deliver the content over the second digital medium. For example, when supplemental content is being delivered to the same users with interactive television, the member can receive content based on his profile and segment data via the television and additional content can be received by the member on his computer via a website link. Additionally, a user may access his e-mail over his desktop computer which may select ads based on the user profile and segment data based on the cookies on his desktop computer that are stored at a central server, and may also send the same information to the user on his PDA based on the same set of underlying profile and segment data. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to provide the audience member with access to a second digital medium, share profile data in common between the two mediums, associate the audience member with a segment of audience members based on the common profile data, and deliver the content over the second digital medium to allow the user to receive targeted content on either medium over which he chooses to view the requested content.

In support of this Official Notice, Examiner would like to point out to the Applicant that Shoff et al. Publication Number 2001/0001160 teaches providing an audience member with access to a second digital medium, it teaches presenting programming on an interactive television and advertisements on a computer screen concurrently (see at least abstract, page 2 paragraphs 15-18, and Figures 2-4). Additionally, the attached article by Susan Spencer, titled, "Phone, Cable Firms Fight for 'Last Mile,'" teaches how

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companies such as Comcast bundle phone, Internet, and cable TV services and put them on one bill, and therefore it is inherent that there is one account per person and the profile data between the different mediums of phone, Internet, and cable TV are shared, since the three services are provided by the same carrier, namely Comcast (see at least abstract).

Response to Arguments

21. After careful review of Applicant's remarks/arguments filed on 02/11/2008, the Applicant's arguments with respect to claims 8-11, 13-23, and 25 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to claims 8-11, 19, and 25 have been entered and considered.

22. Applicant argues that Merriman does not teach the step of associating an audience member with a segment of audience members. The Examiner respectfully disagrees and would like to point the Applicant to col. 6 lines 3-11 where it is stated that several advertisements may be targeted at people who may be interested in computers for example, and therefore people interested in computers is a group or segment of users.

23. Applicant also argues that Merriman fails to disclose the steps of determining the absence of a cookie with a unique identifier for the audience member and setting a unique identifier in a second cookie as a result in reference to claims 9 and 10. The Examiner respectfully disagrees and would like to point the Applicant to col. 5 lines 19-30 where it is explained if a user identifier can't be found, then a new cookie is created with the user's identification number.

24. Applicant argues that Merriman fails to disclose the step of defining a segment of audience members by rules that recognize any common affinity between two or more audience members recited in claim 15. The Examiner respectfully disagrees and would like to point the Applicant to col. 6 lines 3-11 where it is disclosed that members who like computers can be targeted for advertisements.

25. Applicant argues that Merriman fails to disclose the steps of comparing the profile data of a plurality of audience members and forming a segment of audience members based on the comparison as recited in claims 17 and 21. The Examiner respectfully disagrees and would like to point the Applicant to col. 6 lines 3-11 where it is disclosed that members who are interested in computers can form a segment of the audience that can be targeted with advertisements targeted to them.

26. The Applicant argues that in reference to the Official Notice, it is not well known to provide an audience member with access to a second digital medium and to share profile data in common between the two mediums. In support of this Official Notice, Examiner would like to point out to the Applicant that Shoff et al. Publication Number 2001/0001160 teaches providing an audience member with access to a second digital medium, it teaches presenting programming on an interactive television and advertisements on a computer screen concurrently (see at least abstract, page 2 paragraphs 15-18, and Figures 2-4). Additionally, the attached article by Susan Spencer, titled, "Phone, Cable Firms Fight for 'Last Mile,'" teaches how companies such as Comcast bundle phone, Internet, and cable TV services and put them on one bill, and therefore it is inherent that there is one account per person and the profile data

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between the different mediums of phone, Internet, and cable TV are shared, since the three services are provided by the same carrier, namely Comcast (see at least abstract).

27. While the Applicant addressed some of the 35 U.S.C. 112 rejections that were previously made by the Examiner, the Applicant amendments have caused the introduction of new 35 U.S.C. 112 rejections as explained in the Office Action above.

28. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622

/Yehdega Retta/

Primary Examiner, Art Unit 3622